

REMARKS / ARGUMENTS

35 USC §112, second paragraph

The examiner entered a 35 USC §112, second paragraph objection for indicating lack of antecedent basis of the term "internet" within claims (see Detailed Action items 1 and 2). Claims have been amended from "the internet" to "the Internet" to obviate this objection. Antecedent basis for the use of "the Internet" is present in the specification beginning on page 7, line 19 to page 13, line 3. In addition, Figure 5, Figure 6, Figure 7, Figure 8 and Figure 9 refer to the use of the Internet. Related description for these figures is found in the specification beginning page 28, line 1 through page 36, line 14. The term "the Internet" is specifically identified on page 7, line 19. As the specification provides antecedent basis for use of "the Internet" in the claims, applicant respectfully requests this objection be withdrawn.

37 CFR 1.56 - Inventorship

The invention claimed in parent patent application, serial number 08/869,753 noted three inventors. In contrast, only two inventors were involved in the conception and reduction to practice of the presently claimed invention. This fact has been confirmed by the named inventors (i.e. that Michael Cudemo III is not an inventor of this invention). The "Related Applications" portion of the specification has been revised to "continuation-in-part" to better identify this invention having different inventorship as well as claiming use of the Internet.

Corrections

The paragraphs on page 29 of the specification are being corrected to revise the designation of the database containing advertising messages (i.e. advertising messages stored in "database 2"). The advertising message

Appl. No. 09/420,002
Amtd. dated Jun 30, 2003
Reply to Office action of Jan 30, 2003

database is better designated as database 2 in order to conform to designations found elsewhere in the specification. These changes do not add any new matter.

The paragraph beginning on page 35 of the specification is being corrected to identify the application as a nonprovisional application.

Claim Rejections

Examiner has entered a 35 USC §103(a) obvious type rejection of claims 13 through 22 over U.S. Patent 5,557,658 to Gregorek *et al.* (Gregorek '658) in view of U.S. Patent 6,018,770 to Wynblatt *et al.* (Wynblatt '770). Applicant responds that the claimed invention is not obvious over Gregorek '658 in view of Wynblatt '770 for the following reasons:

Gregorek '658 is directed at transmitting advertising messages to a telephone set user during idle times such as when the caller is waiting for a call to be connected or when a caller is placed on hold. Messages are primarily transmitted as audio messages to be heard by a caller. Gregorek '658 discloses an apparatus that replaces central office switching for public switched telephone networks (PSTN) in order to be able to detect when a caller is on hold and to play audio messages to the caller during those periods of time.

In contrast, the present invention transmits advertising messages to a computer user connected to the Internet in primarily visual or textual format. The present invention is not limited to PSTN networks, but rather uses the data packet transmission protocols associated with the Internet, for example user datagram protocol (UDP) or transmission control protocol (TCP).

The present invention also differs from Gregorek '658 in the motivations of a consumer or user. In Gregorek '658 a caller is trying to reach another party. The Gregorek '658 intercepts this request and plays recorded advertising while the connection goes through or during times the caller is on hold. The caller is identified as to the telephone he is calling from. The Gregorek '658 message generator may select advertising by the location of the caller or other non-caller

Appl. No. 09/420,002
Amdt. dated Jun 30, 2003
Reply to Office action of Jan 30, 2003

related parameters as time of day, day of week, week of month, month of year "or other time frame reference."

In contrast, consumers of the present invention are not motivated by a desire to connect to another person but rather to obtain information provided by a limited source (for example school grades provided by the school). Advertising is transmitted simultaneously or sequentially with the information requested in a "piggy-back" fashion. Consumers are identified by the data they transmit to the system of the present invention. They provide this data in order to retrieve "their own" information. As a result, advertising that an ad server transmits to a consumer can be extremely selective (or not sent if inappropriate for a particular consumer).

As the consumer enters identification data, the present invention does not rely upon the calling station identification (e.g. caller telephone number, Internet Protocol address, etc.) Consumers may connect to the apparatus of the present invention from any Internet attached computer or terminal.

The present invention also does not need to wait for dial tones, hold signals and the like to determine when to transmit advertising messages. Advertising is transmitted piggy-back with the consumer requested information. If a consumer is never placed on hold or a dial-tone signal is too short, the ads server of the present invention is able to display its customized ads.

Figure 11a of Gregorek '658 identifies that the apparatus either always activates playing of messages 172 or optionally limits advertising to subscribers 174. Before either automatic playing of ads 172 or subscriber playing of ads 174 is initiated, the caller establishes a connection to the Gregoreck '658 apparatus by "removing the handset" and triggering an off-hook signal (col 19, line 27). In contrast, the present invention relies upon an Internet connection that is initiated by the consumer transmitting identifying data and not by lifting a telephone handset.

The above advantages highlight many of the differences between the present invention and the apparatus of Gregorek '658. As a result, applicant

respectfully submits that the present invention is not obvious in light of Gregorek '685.

The invention of Wynblatt '710 is "a set of software technologies and a user interface paradigm which can be used to access the World Wide Web in a situation where a computer monitor and/or keyboard are not readily available. For example the Wynblatt '710 invention is useful to commuters not having a computer connected to the Internet or for cellular telephone subscribers desiring to connect to the Internet. In contrast, the present invention allows for use of a computer, computer monitor and keyboard. The Wynblatt '710 invention converts textual HTML formatted documents into an audio retrievable and audio playable form. In contrast, the present invention does not require or need such a text to audio format conversion.

It is unclear what the motivation would be for combining the teachings of Gregorek '658 with Wynblatt '710. Assuming, arguendo that such a motivation could be found, the combination would produce primarily audio advertising, selected by subscriber telephone number and listened to when a caller is on hold or waiting for a connection to another person. In contrast, the present invention responds to identity data transmission, supplies limited access data for that individual and piggy-backs primarily visual or textual advertising. As the combination of Gregorek '658 with Wynblatt '710 does not make the present invention obvious, applicant respectfully requests removal of the 35 USC §103(a) rejection.

New claims 23 through 28 add the limitation that the information contained in the first database is limited access information, for example student grades. The examples of the specification discuss the use of the invention with limited access information, and specifically identify student grades as a preferred embodiment. The advantage of using limited access information is that a consumer can retrieve the information only from a limited number of locations where advertising messages are linked to information. In this fashion, the consumers become a "captive audience" unable to avoid the receipt of

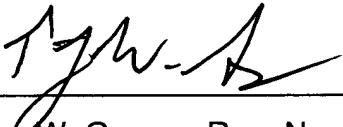
Appl. No. 09/420,002
Am dt. dated Jun 30, 2003
Reply to Office action of Jan 30, 2003

advertising messages. As the examples and the specification fully describe the use of limited access information and as the new claims add this limitation to otherwise allowable claims, their allowance is also proper (for example, claim 23 adds the limitation "limited access" to claim 13, claim adds the "limited access" limitation to claim 20).

Subsequent to entry of the above amendments, applicant respectfully requests that a timely Notice of Allowance be issued in this case. Should any further questions arise concerning this application or in the event the above amendments do not place the application in condition for allowance, applicant respectfully requests a telephone interview. Attorney for the applicant may be reached at the number listed below.

Respectfully submitted,

Roberts Abokhair & Mardula, LLC

By 

Timothy W. Graves, Reg. No. 45,940
Tel.: (703) 391-2900
Fax: (703) 391-2901